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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,216	09/11/2003	Sanjay George Mathias	130128	7700

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Armstrong Teasdale LLP
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EXAMINER

KISH, JAMES M

ART UNIT	PAPER NUMBER
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3737

MAIL DATE	DELIVERY MODE
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08/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/660,216

Applicant(s)

MATHIAS ET AL.

Examiner

James Kish

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-10,12-15,17,19,20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-6, 8-10, 12-15, 17, 19-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 4-6, 8-10, 12-15, 17, 19, 20 and 22-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4-6, 8-10, 12-15, 17, 19-20 and 22-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 8, 12, 17 and 22 fail to particularly point out and distinctly claim the subject matter for the following reasons.

These claims require "introducing a time delay into the first ECG using a filter." This statement leads one to believe that the sole reason for the filter is for introducing a time delay. Page 6 of the specification states, "Additionally, first ECG signal 220 is filtered using MRI filter 214. Filtering first ECG signal 220 facilitates generating more accurate phase information while also introducing a time delay into the filtered output of MRI noise filter 214."

Furthermore, these claims require, "generating a phase-delayed [or second] ECG of the heart at the first phase using the time-delayed first ECG." It is unclear as to how the time-delayed first ECG is used to generate a phase-delayed, or second, ECG.

Furthermore, these claims require, "determining if the phase-delayed ECG and the first ECG have the same approximate information." The two ECGs would inherently have the same *approximate* information because they are derived from one another. The phase-delayed ECG has undergone several steps of processing in comparison to the first ECG, however, unless the system itself is malfunctioning the information will be *approximately* the same. In its broadest terminology, "the same approximate information" can be interpreted as both signals being representative of a patient's heartbeat at the same instance and therefore have the same approximate information.

Furthermore, these claims require, "generating an image of the heart if the phase-delayed ECG and the first ECG have the same approximate information." See the previous paragraph with regards to the use of "approximate." This statement leaves the claim incomplete. There is no method step provided for the situation in which the two ECGs do not have the same approximate information. Also, it seems that an image of the heart is generated at an arbitrary time in the heart cycle and not at a selected cardiac phase because there is no method step comprising a selection. In other words, it appears that an image is generated whenever the system determines that the phase-delayed ECG and the first ECG have the same approximate information.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 4-6, 8-10, 12-15, 17, 19-20 and 22-24 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

On October 26, 2005, the USPTO published Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility. See: (http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)

These guidelines detail a procedure for determining patent eligible subject matter. As to the independent claims 1, 8, 12, 17 and 22, the first step in this process is whether the claims fall within one of enumerated categories. In the immediate application, the claims are drawn to a process - a "method [system or computer program] for generating an image of a heart at a selected cardiac phase" - and meets this step. However, the analysis does not end here. The next step is whether a judicial exception (abstract ideas, laws of nature, natural phenomenon) is provided in the claim. While abstract ideas alone are not eligible, the claim as a whole must be analyzed to determine whether it is for a particular application of the abstract idea. For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomena. To satisfy the requirement of a practical application, the claimed invention must:

(1) transform an article or physical object to a different state or thing; if no transformation, then

(2) the claimed invention must produce a useful, concrete, and tangible result.

Regarding (1) above, the claims provide a transformation or reduction of an

article to a different state or thing. Accordingly, one must then consider whether the claimed invention produces a useful, concrete, and tangible result.

(1) Useful Result

For an invention to be “useful” it must satisfy the utility requirement of section 101. The USPTO’s official interpretation of the utility requirement provides that the utility of the invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP 2107. It can be argued that the claim does not provide a useful result in that the claim does not actually solve a problem. It does not appear to be specific as to how the problem is solved and, if solved, it is not specific as to the use of this solution.

Regarding the useful result requirement, the claims do not provide a useful result. As broadly interpreted, claim 1 (and all subsequent independent claims) acquire a first ECG, use a filter to introduce a time delay into the first ECG, generate a phase-delayed ECG using the time-delayed ECG, determine if the phase-delayed ECG and the first ECG have the same approximate, and generate an image of the heart if these two ECGs are have the same approximate information. As stated, the filter is used solely to introduce a time delay. Therefore, the two ECGs will inherently have the same information and an image of the heart will always be generated.

(2) Tangible Result

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a 101 judicial exception, in that the process claim must set

forth a practical application of that 101 judicial exception to produce a real world result.

(3) Concrete Result

Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether the process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary skilled artisan.

In view of the above analysis, applicant's claims are processes, systems and computer programs on a computer readable medium which include a judicial exception therein. Upon review of each claim as a whole, there is no useful, concrete, and/or tangible result. Accordingly, the claim is non-statutory under 35 U.S.C. 101.

Conclusion

See PTO-892 for a list of references considered by the Examiner.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Kish whose telephone number is 571-272-5554. The examiner can normally be reached on 8:30 - 5:00 ~ Mon. - Fri..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMK


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